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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,977	11/14/2001	David R. Flores	STR4.PAU.02	5837

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EXAMINER
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STERRETT, JONATHAN G

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/002,977	FLORES ET AL.	
	Examiner	Art Unit	
	Jonathan G. Sterrett	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Summary*

1. **Claims 1-21** are pending in the application.

### *Specification*

2. **Claims 8, 9 and 14-16** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims cite labels for software modules and layers in a strategy engine. These labels (e.g. "a STRATEGY FORMULATION module" and a "business model/phase evolution layer") are considered non-functional descriptive material that provide labels to the functionality already claimed in the previous claim. Thus the labels fail to further limit the subject matter.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 1 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

**Claim 10** recites a system with 3 software modules without the elements necessary for a system including: a processor and a program stored in a computer

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readable medium.

5. **Claims 1, 3** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **Claim 1**, the preamble describes a system with an engine. The remaining limitations describe three layers of the engine. It is not clear how the 3 layers operate together to form an engine in a strategy management system. While the top and bottom layers are integrated with at least one intermediate layer. There is no interaction cited between the 3 layers to provide the functionality of managing a strategy, therefore the claim is indefinite. For the purposes of examination, the examiner assumes that the at least one intermediate layer interacts between the top and bottom layer to integrate and align the strategic direction and the strategy platform requirements.

Regarding **Claim 3**, the limitation "strategy enabler" is cited. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, the examiner interprets the use of the term 'enabler' to mean an element that supports the development of the strategy platform for the purposes of enabling the strategy platform to achieve the strategic vision.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-20** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. In order to be statutory, the claimed invention must produce a useful, concrete, and tangible real-world result. An invention that fails to produce a tangible result is one that involves no more than the manipulation of an abstract idea. In order to be concrete, the result must be substantially repeatable or reproduce the same result. The result is useful when there is a real-world practical application.

**Claim 1** recites three layers in a strategy formulation engine in a system that are adapted to define a strategic direction, include a plurality of platform requirements, and integrate the strategic directions with the platform requirements. These limitations fail on all the requirements under 35 USC 101. First, since the system is not tangibly embodied, it is considered to be an abstract idea. The layers in the engine are adapted to perform various functions that appear to be subjective, and thus fail the concrete test as the system would not produce a result that is repeatable. Finally, there is no real-world practical application recited and the system is considered to fail the useful test.

**Claim 10** recites three software modules that are adapted to formulate a strategy description, align the strategy description, measure the performance of the strategy and identify opportunities. These limitations fail on all the requirements under 35 USC 101. First, since the system is not tangibly embodied, it is considered to be an abstract idea. The software modules are adapted to perform various functions that appear to be subjective, and thus fail the concrete test as the system would not produce a result that is repeatable. Finally, there is no real-world practical application recited and the system is considered to fail the useful test.

**Claim 18** recites a series of steps that are adapted to formulate a strategy description, align the strategy description, implement the strategy and identify opportunities. These limitations fail on all the requirements under 35 USC 101. First, since the steps are not tangibly embodied, they are considered to be an abstract idea. The steps are adapted to perform various functions that appear to be subjective, and thus fail the concrete test as the steps would not produce a result that is repeatable. Finally, there is no real-world practical application recited and the steps are considered to fail the useful test.

Therefore **Claims 1-20** are directed towards a non-statutory subject matter.

**Claim 10** cites data structures (i.e. software modules) without claiming that the data structures as being tangibly embodied in computer-readable media. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2 at 1760.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 10-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-10** of copending Application No. **09/947455**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of the term "strategy description" and "multilayered strategy description" are recognized by one of ordinary skill in the art as having the same meaning. A multilayered strategy description as claimed would also include a simple strategy description. Thus the claims are not patentably distinct from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McGrath**.

McGrath, Michael E; "Setting the PACE in Product Development", Chapter 7 – The Process of Product Strategy, 1996, Elsevier, pp.101-119.

Regarding **Claim 1**, McGrath teaches:

**a top layer including a definition of a strategic direction;**

Page 102 Figure 7-1, the McGrath strategy pyramid has a top layer that has the strategy vision (i.e. a definition of a strategic direction – see also page 103 para 1 and para 3).

**a bottom layer including a plurality of strategy platform requirements; and**

page 105 para 3, the product platform (i.e. strategy platform elements) contains a number of technical elements. The definition of these technical elements comprise the strategy platform requirements – see para 2.



**at least one intermediate layer integrating the strategic direction and the strategy platform requirements.**

Page 103 para 6, the strategic direction taught by McGrath directs the platform requirements. The intermediate layer is then, the product platform strategy that integrates the strategic direction with the embodiment of the strategy into the strategic platform requirements.

McGrath does not teach his approach to strategy to be embodied in a computer system into an engine, however, Official Notice is taken that the use of computers to automate processes, including using engines in a system, is old and well known in the art. Computer automation provides the benefits of making the process faster, easier to use and more efficient.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McGrath, regarding providing an integrated approach to integrating a strategic vision with a platform strategy, to include the step of using a computer system with an engine to operate the strategic process, because it would provide the benefits of making the process faster, easier to use and more efficient.

Regarding **Claim 2**, McGrath teaches:

**wherein the strategic direction includes a vision statement and a target**

**date.**

Page 103 para 1, strategic direction includes the vision (i.e. vision statement) – see also para 2, the vision (i.e. vision statement provides the context and direction).

Page 103 para 1, the vision includes timing (i.e. a target date).

Regarding **Claim 3**, McGrath teaches:

**wherein each strategy enabler includes a definition of future requirements that are necessary for the strategy enabler to assist in achieving the strategic direction.**

Page 104 para 4, the technology development agenda provides a definition of future technological developments that are necessary for achieving the strategic direction. The agenda provides for definition of future requirements that enable the company to succeed (i.e. a strategy enabler).

Regarding **Claim 4**, McGrath teaches:

**wherein the strategy platform requirements may be directly transformed into implementation activities.**

Page 104 para 3, the strategy platform requirements operating through the strategic vision direct product development activities. Platform requirements determine what development teams will work on from a platform element standpoint (i.e. what building blocks do development teams work with) and also how the strategy platform requirements determine product line planning, i.e. implementation activities (see page

105 para 3 and page 107 Figure 7-2).

Regarding **Claim 5**, McGrath teaches:

**wherein the at least one intermediate layer includes a plurality of strategy platforms.**

Page 103 para 6, the product platform strategy integrates the strategic direction with the platform requirements (see page 105 para 2 & 3).

Regarding **Claim 6**, McGrath teaches:

**wherein each of the strategy platforms includes at least one of the strategy platform requirements.**

Page 105 para 2 & 3, strategy platforms (i.e. strategic product platforms) include a series of requirements stating what the common technical elements will be that are integrated into a range of products.

Regarding **Claim 7**, McGrath teaches:

**wherein each of the strategy platforms includes at least one value creation opportunity.**

Page 105 para 2 & 3, McGrath's strategic product platforms include at least one value creation opportunity as embodied in various products that go to market utilizing the product platform strategy.

Regarding **Claim 8**, McGrath teaches:

**A business model/phase evolution layer.**

Figure 7-1, product line strategy (i.e. a business model/phase evolution layer) incorporates the above product platform strategy into its next lower level of implementation.

Regarding **Claim 9**, McGrath teaches:

**A strategy platform integration layer.**

Figure 7-1, new product development layer (i.e. a strategy platform integration layer) integrates the strategy platform into the development of various products that follow the strategy platform.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 10-20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Honarvar US 6,708,155** (hereinafter Honarvar).

Regarding **Claim 10** Honarvar teaches:

**a first software module adapted to formulate a multi-layered strategy  
description based on an assessment of environmental data;**

column 3 line 1-5, a strategy is formulated from a decision support system based on input data – see column 3 line 40-44, data elements are passed into the system (i.e. environmental data is passed into the system to formulate a strategy). Since the data represents more than one grouping of customers, the strategy to be formulated is a multi-layered one.

**a second software module adapted to align the multi-layered strategy  
description with available enterprise resources and deploy strategy  
implementation responsibilities; and**

column 3 line 45-48, the software groups the segments (i.e. specific groupings of customers) and the segments are then subdivided further to align these groups of customers with available enterprise resources (see column 4 line 24-30). This aligning is performed through the use of function sets.

**a third software module adapted to measure the performance of the  
strategy and identify opportunities to optimize future strategic performance.**

Column 5 line 36-40, the software examines how effective the various strategies are being implemented through different test cells through a set of common metrics (i.e. measuring the performance). See also column 5 line 60-63, the system adjusts the strategies to optimize results in the future (i.e. optimize future strategic performance).

Regarding **Claim 11** Honarvar teaches:

**wherein the first, second and third software modules are adapted to implement a continuous strategy management cycle.**

Column 3 line 13-15, the decision support system provides continuously evolving decision strategies, i.e. a continuous strategy management cycle.

Regarding **Claim 12** Honarvar teaches:

**wherein environmental data includes performance measures and identified opportunities generated by the third software module.**

Column 6 line 24-28, environmental data includes customers who have high value (i.e. an identified opportunity) and a low probability of attrition. Report groups (i.e. performance measures can be place throughout a decision strategy (i.e. including a third software module) to ensure that performance results are accumulated for each part of the decision strategy.

Regarding **Claim 13** Honarvar teaches:

**wherein the software modules are adapted for execution in any order.**

Column 5 line 48-55, the system flows in the decision management system can be executed in any logical order.

Regarding **Claims 14-16**, the claims recite limitations similar to those addressed by the rejection of **Claim 10** above, and are rejected under the same rationale. The

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examiner notes that the use of labels in the claims constitute non-functional descriptive material and are not granted any patentable weight in the claim.

Regarding **Claim 17** Honarvar teaches:

**wherein the first software module is further adapted to analyze strategic alternatives and determine a final strategy decision.**

Column 5 line 34-35, the final offer selection (i.e. strategy decision) is reached through a decision tree (i.e. an analysis of strategic alternatives). See also column 5 line 14-16, final strategic decisions are reached through different functions, i.e. analyses including scoring or decision trees.

Regarding **Claim 18** Honarvar teaches:

**formulating a multi-layered strategy description with integrated implementation requirements;**

column 3 line 1-5, a strategy is formulated from a decision support system based on input data – see column 3 line 40-44, data elements are passed into the system (i.e. environmental data is passed into the system to formulate a strategy). Since the data represents more than one grouping of customers, the strategy to be formulated is a multi-layered one.

Column 3 line 46-48, the strategy includes integrated implementation requirements in the rules in how customers are segmented.

**aligning the multi-layered strategy with available enterprise resources;**

column 3 line 45-48, the software groups the segments (i.e. specific groupings of customers) and the segments are then subdivided further to align these groups of customers with available enterprise resources (see column 4 line 24-30). This aligning is performed through the use of function sets.

**implementing the strategy in accordance with the alignment;**

column 4 line 46-54, the segmentation strategy as described above is implemented in accordance with the alignment (as determined by the function sets).

**and identifying new strategic opportunities;**

column 6 line 21-28, customers can be segmented to identify strategic opportunities in according to the segments (e.g. group of high potential value customers).

**wherein the steps of formulating, aligning, implementing and identifying are repeated to form a continuous strategy management cycle.**

Column 3 line 1-5, the strategy process defined by Honarvar, including the steps of formulating, aligning, implanting and identifying, are repeated to form a continuous cycle to optimize performance.

**Claim 19** recites limitations similar to those addressed in the rejection of **Claim 13** above, and is therefore rejected under the same rationale.



Regarding **Claim 20** Honarvar teaches:

**wherein the layers of the multi-layered strategy description may be completed in any order.**

Column 3 line 46-48, the various segmentation of customers (i.e. the multi-layered strategy) can be applied in any order. The result is the same since the segmentation of high valued customers from low-valued customers results in the same segmentation (i.e. layers).

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by **McGrath**.

Regarding **Claim 21**, McGrath discloses:

**assessing the internal and external environment;**

Page 102 para 2, assessing the external environment is a key element in McGrath's teachings regarding a product strategy.

Page 104 para 4, assessing the internal environment is done in determining what technologies need to be developed.

**formulating strategic alternatives based on the environmental assessment,**

page 103 para 6, product platform plans are strategic alternatives for different product platforms – the development of PPP's is based on the environmental assessment.

**each strategic alternative having a unique multi-layered strategy description;**

page 105 para 3, product platform plans contain a unique multi-layered product strategy description. The platform elements that make up the platform plan are multi-layered, described as being part of the platform and are unique to that particular platform. (see page 106 para 4 & 5).

**comparing the formulated strategic alternatives;**

page 106 para 1, a product platform strategy is effective when it compares the strategic alternatives (i.e. product platform plans) to determine where there are gaps.

**determining a final strategy description;**

page 106 para 1, aggregate product platforms plans are a final strategy description of how a company will use a product platform approach to guide subsequent development of products and product lines.

**and approving a final strategy solution.**

Page 105 para 1 The product strategy vision rests clearly with the CEO or the head of the business unit (i.e. they have to approve it)– see also Page 102, Figure 7-1. The underlying elements in McGrath's product strategy pyramid from the vision down to new product development also require approval from the CEO or business unit head. See also page 109 para 7, tactical phase decisions for product platform development

lie with the Product Approval Committee (PAC), who approves the development of the product platform at the end of each phase.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20030187716 by Lee discloses a visual interface for interactive analysis of business expenditure.

US 20040059627 by Baseman discloses a method for integrated supply chain and financial management.

US 20040068429 by MacDonald discloses a method for strategic plan development.

US 20040093232 by Murray discloses a method of organizing strategic information.

US 20040107125 by Guheen discloses a method for business alliance identification in a web architecture.

US 5875431 by Heckman discloses a method for strategic analysis planning.

US 5999908 by Abelow discloses a method for obtaining product information.

US 6405159 by Bushey discloses a method for categorizing, describing and modeling system users.

US 6411936 by Sanders discloses a enterprise value enhancement system and method.

US 6556974 by D'Allesandro discloses a method for evaluating current business

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performance.

Elsawy, Omar A; Malhotra, Arvind; Gosain, Sanjay; "IT-intensive value innovation in the electronic economy: Insights from Marshall Industries", Sept 1999, MIS Quarterly, 23, 3, 305, Dialog 11787125 58530838.

Mahoney, Joseph T; Pandian, J. Rajendran: "The Resource-Based View Within the Conversation of Strategic Management", June 1992, Strategic Management Journal, v13n5, pp.363-380, Dialog 00727030 93-76251.

### ***Conclusion***


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 2-16-2006

JGS

  
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